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BEYER WEAVER LLP			RYMAN, DANIEL J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/080,995

Applicant(s)

WANG ET AL.

Examiner

Daniel J. Ryman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-20,24-27 and 41-59 is/are pending in the application.
- 4a) Of the above claim(s) 18-20,24-27 and 41-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,15,17 and 49-59 is/are allowed.
- 6) ☒ Claim(s) 2-7,9-14,16 and 44-48 is/are rejected.
- 7) ☒ Claim(s) 1,15-17 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/19/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see Response, filed 19 October 2007, with respect to the rejection of claims 1-7, 9-14, and 16 under 35 U.S.C. § 101 have been fully considered and are persuasive. This rejection has been withdrawn.
2. Applicant's arguments, see Response, filed 19 October 2007, with respect to the rejection of claims 15 and 17 under 35 U.S.C. § 103 have been fully considered and are persuasive. The rejection of claims 15 and 17 has been withdrawn.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: in line 4, "access point information" should be "access point information of the second access point" to distinguish the received access point information from the access point information stored in the list of active access points; in line 5, "access point information" should be "access point information of the second access point"; in line 6, "access point information" should be "access point information of the second access point"; and in line 9, "access point information" should be "access point information of the second access point". Appropriate correction is required.
4. Claim 15 is objected to because of the following informalities: in line 4, "access point information" should be "access point information of the second access point" to distinguish the received access point information from the access point information stored in the list of active access points; in line 5, "access point information" should be "access point information of the second access point"; in lines 6-7, "access point information" should be "access point

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information of the second access point”; and in line 9, “access point information” should be “access point information of the second access point”. Appropriate correction is required.

5. Claim 16 is objected to because of the following informalities: in line 6, “access point information” should be “access point information of the second access point” to distinguish the received access point information from the access point information stored in the list of active access points; in line 7, “access point information” should be “access point information of the second access point”; in line 9, “access point information” should be “access point information of the second access point”; and in line 11, “access point information” should be “access point information of the second access point”. Appropriate correction is required.

6. Claim 17 is objected to because of the following informalities: in line 5, “access point information” should be “access point information of the second access point” to distinguish the received access point information from the access point information stored in the list of active access points; in line 7, “access point information” should be “access point information of the second access point”; and in line 9, “access point information” should be “access point information of the second access point”. Appropriate correction is required.

7. Claim 57 is objected to because of the following informalities: in line 2, “point information indicates” should be “point indicates”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 2-7, 9-14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. Claim 16 recites: “at least one of the processor or the memory being adapted for: . . . sending the access point information to a third access point”. This recitation allows for the possibility that the memory will send access point information to a third access point. The Specification fails to teach how a memory transmits information on a network. As such, claim 16 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

12. Claims 44-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “located on” in claim 44 is used by the claim to mean “the home network of the mobile”, while

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the accepted meaning is “the network to which the mobile is currently attached.” The term is indefinite because the specification does not clearly redefine the term.

14. Claim 51 recites the limitation "prior to deleting the set of access point information" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 2-7, 9-14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Heller (US 2002/0147837), of record.

17. Regarding claims 2-7, 9-14, and 16, Heller discloses a first access point that supports mobility for a node that does not support Mobile IP (§ [0020], where Heller’s invention obviates the need for installing Mobile IP software on mobile nodes, such that the mobile nodes do not support Mobile IP, by using base stations, i.e. access points, that support mobility for a node, see also §§ [0016]-[0017]), the access point comprising: a processor (§ [0026], where the proxy is a computer, i.e. a processor); and a memory (§ [0028], where the “database” is a memory), at least one of the processor or the memory being adapted for: enabling a third access point, which is active, to compare a received data packet with the access point subnet to determine whether to send a registration request on behalf of the node using the gateway as the node's Home Agent (§ [0018], where a base station, i.e. an access point, receives a link layer message, i.e. a data packet, and uses the

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identity of the MN, i.e. access point subnet (since the address of the MN includes the subnet address of its home access point subnet, ¶ [0006]), to determine whether to send a registration request on behalf of the node to the node's HA and where the HA is a gateway, as shown in Fig. 3). Heller also discloses that the third access point performs the registration using access point information identifying an access point subnet and a gateway (¶ [0029], where a base station, i.e. an access point, performs registration on behalf of the node using the identity of the MN, i.e. access point subnet, and an HA address, i.e. a gateway, as shown in Fig. 3). Heller further discloses that the third access point retrieves address information from a database, although Heller fails to specify how the database obtains this address information (¶ [0018], where the access point "retrieves Mobile IP information from a database based on the identity of the MN," including "an IP address for each of the MN, FA and HA plus other information needed to perform the mobile IP registration.").

Examiner notes that Heller does not expressly disclose receiving access point information from a second access point; storing the access point information such that a list of active access points is updated to include the access point information, the list of active access points including access point information associated with one or more active access points, the access point information including information identifying an access point subnet and a gateway associated with the second access point; and sending the access point information to a third access point that supports Mobile IP to notify the third access point that the second access point is an active access point, thereby enabling the third access point to perform the registration. However, the aforementioned limitations are intended use limitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. In this case, the recitation of the intended use of the claimed invention fails to result in a structural difference since the recited structure of the claimed invention constitutes only a processor and a memory, where such structures are taught by Heller, as outlined above. Since the prior art structure is capable of performing the intended use, it meets the claim.

Claims 2-6, 9, 11, and 12 only further limit the intended use limitations of claim 16, such that these claims fail to recite limitations which result in a structural difference between the claimed invention and the prior art.

Claims 7, 10, 13, and 14 similarly only recite intended use limitations which fail to result in a structural difference between the claimed invention and the prior art.

***Allowable Subject Matter***

18. Claims 1, 15, 17, and 49-59 are allowed for the reasons outlined in the Response filed 19 October 2007.

19. Claim 44-48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 8:00am-4:30pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel J. Ryman  
Examiner  
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